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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,754	09/28/2001	Yoshihiro Itoh	05905.0153	3110

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EXAMINER

LABAZE, EDWYN

ART UNIT PAPER NUMBER

2876

DATE MAILED: 10/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/964,754

Applicant(s)

ITOH ET AL.

Examiner

EDWYN LABAZE

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-24 are rejected under 35 U.S.C. 102(b) as being unpatented by Cohen et al. (U.S. 5,373,440).

Re claims 1 and 13: Cohen et al. discloses a promotional game method and apparatus, wherein the data contains an identification indicator (col.6, lines 40-48) and is downloaded through a communication line by a user/patron by using a communication terminal or computer (col.7, lines 4-12).

Re claims 2 and 14: Cohen et al. teaches a system, wherein the communication terminal is specified in advance and prohibited from downloading the same data repeatedly (col.88, lines 40-45).

Re claims 3 and 15: Cohen et al. discloses a system, wherein the communication terminal generates the identification indicator (col.5, lines 59-63 and col.7, lines 10-24).

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Re claims 4 and 16: Cohen et al. teaches a system, wherein the communication terminal is a game device 10 (col.5, line 3) and the data is the game performed on this game device (col.13, lines 61 –68 and col.14, lines 1-8).

Re claims 5 and 17: Cohen et al. discloses a system, wherein the value of the service ticket changes or updates according to conditions such as the data downloading status (col.14, lines 23-58).

Re claims 6 and 18: Cohen et al. teaches a system, wherein an effective term/period is set for the ticket (col.7, lines 54-62).

Re claims 7 and 19: Cohen et al. discloses a system, wherein a carrier is capable of retaining data as the service ticket is specified (col.9, lines 18+).

Re claims 8 and 20: Cohen et al. teaches a system, wherein a service provider is specified, who provides a service corresponding to the service ticket (col.12, lines 8-20).

Re claims 9 and 21: Cohen et al. discloses a system, wherein a service provider is specified, who provides a service corresponding to the service ticket and wherein the service provider has equipment to which the carrier can be connected (col.14, lines 9-20).

Re claims 10 and 22: Cohen et al. teaches a system, wherein the carrier 34 displays a bar code (col.7, lines 17-20) for indicating the service ticket and the equipment comprises a bar code reader (col.6, lines 21-27) for reading the bar code.

Re claims 11 and 23: Cohen et al. discloses a system, wherein the equipment 32 or 38 identifies the identification indicator (col.6, lines 49+).

Re claims 12 and 24: Cohen et al. teaches a system, wherein the equipment is a game device/card (col.5, lines 65+).

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Re claim 25: Cohen et al. discloses a service method, which includes a server/computer (col.14, lines 51-54) for a service provider to manage user/patron information and deliver contents requested by a user (col.6, lines 37-48); an information processing terminal having storage means for storing the contents (col.14, lines 1-4) and display an image on a screen by using image data contained in the contents (col.90, lines 11-21); and a service provider terminal having matching means for reading user/patron data contained in the contents stored in the information processing terminal, and for matching that user with user data in the server, determination means for determining an appropriate user on the basis of the matching, means for providing a specified service to the user when the determination means identifies the user as an appropriate user, sending means for sending service completion information to the server at the time of the completed service (col.7, lines 49-55) , and means for deleting the contents of the completed service in the information processing terminal (col.8, lines 26-41); wherein the user brings the information processing terminal to a service facility where the service provider terminal is provided, and the service providing terminal provides terminal provides the user with a service according to the contents stored in the information processing terminal (col.3, lines 16-28).

Re claim 28: Cohen et al. teaches a machine readable storage medium having a program stored therein for causing a computer to download data in the service ticket issuing system (col.14, lines 42-58).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen et al. (U.S. 5,373,440) in view of Laing et al. (U.S. 5,534,857).

Re claim 26: The teachings of Cohen et al. have been discussed above.

Cohen et al. fails to disclose means to create/generate enciphering codes or bar codes.

Laing et al. teaches a method and system for secure, decentralized personalization of smart cards, which includes means of generating an enciphered code or bar code (col.6, lines 45-67 and col.7, lines 1-13).

In view of the teaching of Laing et al., it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ the enciphering code design into the teaching of Cohen et al. in order to protect and secure the genuineness, personal and secret information of the user/patron. The enciphering code can be used both to transmit the usage data in a secure manner and for forming, on the basis of certain data stored in the card, an authenticity code which can be used in the verification procedure. Furthermore, the enciphering method prevents safe common ownership of the key. Moreover, such modification would have been an obvious extension as taught by Cohen et al., and therefore an obvious expedient.

Re claim 27: Cohen et al. further discloses a system wherein the service providing facility or establishment comprising of a plurality of products (col.5, lines 37-63), each having a bar code display thereon, the user causes the bar code reader to read the bar code displayed on the a product selected among the products and to sent the selected product bar code (col.14, lines 9-23) to the server, and wherein on the basis of the received selected product bar code, the server

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identifies the selected product among the registered products (col.9, lines 52+), create a new bar code enciphering (see the discussions set forth in claim 26) a specific service content regarding this product and sends image data containing the new bar code to the user.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hekstra (U.S. 5,753,898) discloses a method for being capable of carrying out, with the same data carrier, various authentication process, as well as system.

Goreta et al (U.S. 5,859,913) teaches a method and system for the high-speed generation and transmission of a sequence of characters.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (703) 305-5437. The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

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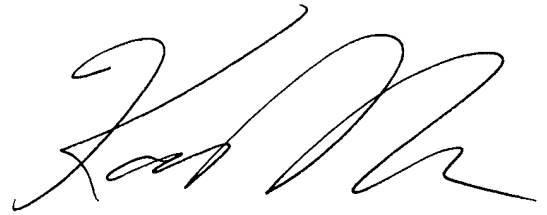
el

Edwyn Labaze

Assistant Examiner

Technology Center 2876

September 13, 2002

A handwritten signature in black ink, appearing to read 'Karl D. Frech', written in a cursive style.

KARL D. FRECH
PRIMARY EXAMINER